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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,415	06/05/2001	Nathan Karin	01/21982	1850

7590 10/03/2003

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EXAMINER

HADDAD, MAHER M

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/873,415	KARIN, NATHAN	
	Examiner	Art Unit	
	Maher M. Haddad	1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-54 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented.

Claim 29 is missing, therefore, misnumbered claims 30-55 have been renumbered as claims 29-54 according to 37 CFR 1.126.

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 1, 5, 7, 10, 13, 16, 18, drawn to a method of breaking-down an immunological tolerance to interferon gamma-inducible protein 10 in a subject with interferon gamma-inducible protein, classified in Class 424, subclass 184.1.
- II. Claims 1-2, 4, 8, 11, 14, 17, drawn to a method of breaking-down an immunological tolerance to interferon gamma-inducible protein 10 in a subject with cells expressing recombinant interferon gamma-inducible, classified in Class 424, subclass 93.1.
- III. Claims 1, 3, 6, 9, 12, 15, 18, drawn to a method of breaking-down an immunological tolerance to interferon gamma-inducible protein 10 in a subject with an expression construct encoding interferon gamma-inducible protein, classified in Class 514, subclass 44.
- IV. Claims 19- 28, drawn to a pharmaceutical composition comprising interferon gamma-inducible protein, classified in Class 424, subclass 184.1.
- V. Claims 29, 30, drawn to a pharmaceutical composition comprising an expression construct encoding interferon gamma-inducible protein 10, classified in Class 514, subclass 44.
- VI. Claims 31-36, drawn to a method of breaking-down an immunological tolerance to interferon gamma-inducible protein 10 in a subject with anti-interferon gamma-inducible protein 10 antibodies, classified in Class 424, subclass 130.1.
- VII. Claims 37-54, drawn to a pharmaceutical composition comprising anti-interferon gamma-inducible protein 10 antibodies, classified in Class 424, subclass 130.1.

3. Groups IV, V and VII are different products. Nucleic acids, polypeptides, and antibodies to the polypeptides differ with respect to their structures and physicochemical properties; therefore each product is patentably distinct.

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4. Groups I-III and VI are different methods. These methods differ with respect to ingredients; therefore, each method is patentably distinct.

5. Groups IV, V, VII and I-III, VI are related as product and process of using. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody of Group VII can be used for affinity purification, in addition to the recited methods. The nucleic acids of Group V can be used for Northern blot hybridization, in addition to the recited methods. The protein of Group IV can be used to make antibodies, in addition to the recited methods.

5. These inventions are distinct for the reasons given above. In addition, they have acquired a separate status in the art as shown by different classification and/or recognized divergent subject matter. Further, even though in some cases the classification is shared, a different field of search would be required based upon the structurally distinct products recited and the various methods of use comprising distinct method steps. Therefore restriction for examination purposes as indicated is proper.

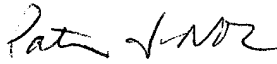
6. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maher Haddad whose telephone number is (703) 306-3472. The examiner can normally be reached Monday through Friday from 8:00 AM to 4:30 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 872-9307.

Maher Haddad, Ph.D.
Patent Examiner
Technology Center 1600
October 1, 2003


PATRICK J. NOON, PH.D.
PRIMARY EXAMINER

10/1/03